

REMARKS

Reconsideration of the present application in view of the remarks below is respectfully requested.

Claims 1-24 were pending in this application. The Examiner stated that Claims 1-6, 8-14 and 16 to 24 were rejected; however, only Claims 1-6, 8-14 and 16-22 were specifically addressed by the rejections made in the action. Claims 7 and 15 were objected to. Claims 1-5, 8-13, 20 and 24 have been amended. Claims 21 to 23 have been canceled. New Claims 31 and 32 have been added. Presently, Claims 1 to 20, 24, 31 and 32 are pending in the present application.

Amendments to the claims are described below. Amendments to Claims 1-5, and 8-13 with the exception of the correction of a punctuation/grammar error in Claim 2, consist of deletion of elements from a Markush group in compliance with the requirement for restriction and do not add new matter to the claims. It is noted that Applicants have made these claim amendments without prejudice to filing a divisional application directed to the deleted subject matter.

Claims 1 and 9 have been amended to comply with the restriction requirement. Heterocyclic moieties have been deleted from the definition of R<sup>1</sup> and Ar<sup>1</sup>.

Claim 2 has been amended to comply with the restriction requirement by deleting heterocyclic moieties from the Markush group defining R<sup>1</sup>. Further, this claim has been amended to correct a punctuation/grammatical error has been corrected in the definition of R<sup>2</sup>.

Claims 3 and 4 have been amended to comply with the restriction requirement. Heterocyclic moieties have been deleted from the definition of Ar<sup>1</sup>.

Claim 5 has been amended to comply with the restriction requirement by deleting the heterocyclic moiety "pyridyl" from the Markush group defining R<sup>1</sup>.

Claim 8 has been amended to comply with the restriction requirement by deleting compounds with heterocyclic moieties at the R<sup>1</sup> and Ar<sup>1</sup> positions

Claim 10 has been amended to comply with the restriction requirement by deleting the heterocyclic moiety "pyridyl" from the Markush group defining R<sup>1</sup>.

Claims 11 and 12 have been amended to comply with the restriction requirement. Heterocyclic moieties have been deleted from the definition of Ar<sup>1</sup>.

Claim 13 has been amended to comply with the restriction requirement by deleting the heterocyclic moiety "pyridyl" from the Markush group defining R<sup>1</sup>.

Claim 20 has been amended to incorporate the limitations of canceled dependent Claims 21, 22, and 23, and is now directed to a method of treating an eating disorder associated with excessive food intake

selected from obesity, bulimia nervosa and compulsive eating disorders. This amendment does not add new matter to the claims, and is fully supported by original Claim 23, as well as the specification. Applicants reserve the right to file a divisional application directed to the deleted subject matter of Claim 20.

Claim 24 has been amended to depend from amended Claim 20 in place of canceled Claim 23. As amended, Claim 20 incorporates the limitations of original Claim 23. This amendment does not change the scope of Claim 24, and does not add new matter to the present application.

New Claims 31 and 32 depend from Claim 8, but are otherwise identical to present Claims 20 and 24, and find support in the specification as filed as well as original Claims 8, and 20 to 24.

The claim amendments detailed above are fully supported by the specification and do not add new matter to the application.

#### **Restriction Requirement**

The Examiner made Applicant's election of species when R<sup>1</sup> and Ar<sup>1</sup> are non heterocyclic final. Applicants have amended the claims to reflect the elected subject matter. In particular, the definition of R<sup>1</sup> and Ar<sup>1</sup> have been amended to delete heterocyclic moieties in Claims 1 and 9; the definition of R<sup>1</sup> has been amended to delete heterocyclic moieties in Claims 2, 5, 10, and 13; the definition of Ar<sup>1</sup> has been amended to delete heterocyclic moieties in Claims 3, 4, 11, and 12; and compounds containing heterocyclic R<sup>1</sup> and Ar<sup>1</sup> moieties have been deleted from Claim 8. Applicants have effected these amendments without prejudice to filing a divisional application directed to the canceled/restricted subject matter.

#### **Claim Rejections – 35 USC § 112**

Claims 18-22 were rejected under 35 USC § 112, first paragraph, because the Examiner stated that the specification, while being enabling for treating obesity, did not reasonably provide enablement for various other diseases as claimed in Claim 21 and did not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Concerning Claims 20 to 22, Applicants have amended Claims 20 and 24, added new Claims 31 and 32, and canceled Claims 21, 22, and 23, without prejudice to filing a divisional application directed to the canceled subject matter. Claim 20 has been amended to incorporate the limitations of dependent Claims 21, 22, and 23, and is now directed to a method of treating an eating disorder associated with excessive food intake selected from obesity, bulimia nervosa and compulsive eating disorders. Claim 24 has been amended to depend from amended Claim 20 in place of canceled Claim 23. As amended, Claim 20 incorporates the

limitations of original Claim 23. New Claims 31 and 32 depend from Claim 8, but are otherwise identical to present Claims 20 and 24. In view of the amendments detailed above, Applicants respectfully submit that Claims 20-22, presently Claim 20, as well as new Claims 31 and 32, are enable by the specification as filed.

In view of the amendments and remarks above, Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 20-22, presently Claim 20 under 35 USC § 112, first paragraph.

Concerning Claims 18 and 19, Applicants respectfully traverse this rejection under 35 USC § 112, first paragraph and submit that the application as filed provides enablement for prevention of obesity in a person at risk for obesity. Claim 18 reads:

A method of preventing obesity in a person at risk for obesity comprising administration to said person of about 0.001 to about 100 mg/kg of a compound according to Claim 1.

Claim 19 differs from Claim 18 in depending from Claim 8. The specification at page 45, lines 9-25 defines prevention of obesity as referring to the administration of the compounds of the present invention to reduce or maintain the body weight of a subject at risk of obesity, and details the outcomes of prevention. The specification at page 44, lines 3-5, clearly and specifically defines a subject at risk for obesity as an otherwise healthy subject with a BMI of 25 kg/m<sup>2</sup> to less than 30 kg/m<sup>2</sup> or a subject with at least one co-morbidity with a BMI of 25 kg/m<sup>2</sup> to less than 27 kg/m<sup>2</sup>. The co-morbidities are particularly defined on page 44, lines 18-27. Claims 18 and 19 are enabled by the specification as filed. The Claims administration of a specified amount ("0.001 to 100 mg/kg") of a defined compound (as specified in Claim 1 and 8, respectively), to a defined subject ("person at risk for obesity") for a purpose ("to prevent obesity") that is well defined in the specification.

In view of the remarks above, Applicants respectfully submit that Claims 18 and 19 are enabled by the specification and respectfully request reconsideration and withdrawal of the rejection of Claims 18 and 19 under 35 USC § 112, first paragraph.

#### Claim Rejections – 35 USC § 102

Claims 1-6, 8-14 and 16-17 were rejected under 35 USC § 102(b) as being anticipated by Ishiwata et al. (Yakugaku Zasshi, 1951). The Examiner stated that Ishiwata et al., page 1273, compound (IV), when R is benzyl and R<sub>1</sub> is phenyl, anticipate instant compounds and composition, especially, when the compounds are in water and water is well known pharmaceutical carrier.

Applicants respectfully traverse this rejection of Claims 1-6, 8-14 and 16-17 under 35 USC § 102(b) over Ishiwata et al. (Yakugaku Zasshi, 1951). Ishiwata et al., discloses the compound of structural formula (IV) as an intermediate in the synthesis of a corresponding isoquinoline derivative of formula (V). There is no independent use of the compound of formula (IV).

As filed, independent Claims 1 and 9 contain the following provisos:

provided that when R<sup>1</sup> and R<sup>2</sup> are unsubstituted aryl or unsubstituted heteroaryl, and R<sup>3</sup> is hydrogen or C<sub>1-4</sub> alkyl, then Ar<sup>1</sup> is substituted with at least one R<sup>b</sup> substituent; (Claim 1)

provided that when R<sup>1</sup> and R<sup>2</sup> are unsubstituted aryl or unsubstituted heteroaryl, and R<sup>3</sup> is C<sub>1-4</sub> alkyl, Ar<sup>1</sup> is substituted with at least one R<sup>b</sup> substituent; (Claim 9).

Independent Claims 1 and 9 do not read on the Ishiwata compound (IV), when R is benzyl and R<sub>1</sub> is phenyl, because in view of the provisos above, the claims 1 and 9 as filed require substitution on the Ishiwata R<sub>1</sub> phenyl, when the Ishiwata R is benzyl. Independent Claims 1 and 9 are not anticipated by Ishiwata.

Claims 2-6, 16, and new Claim 31 depend, directly or indirectly, from Claim 1 and incorporate the limitations of Claim 1, including the proviso above. Claims 10-14 depend, directly or indirectly, from Claim 9 and incorporate the limitations of Claim 9, including the proviso above. Therefore, dependent Claims 2-6, 10-14, 16 and 31 are not anticipated by Ishiwata.

Claim 8 is directed to particular compounds of the present invention. Claim 8 does not claim the compound (IV), when R is benzyl and R<sub>1</sub> is phenyl, and therefore is not anticipated by the Ishiwata reference. Claim 17 and new Claim 32, which depend from Claim 8, do not claim compositions the Ishiwata compound, and are not anticipated by the Ishiwata reference.

In view of the remarks above, Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 1-6, 8-14 and 16-17 under 35 USC § 102(b) over Ishiwata et al. (Yakugaku Zasshi, 1951).

The Examiner noted that Claims 7 and 15 were objected to as being dependent upon a rejected base claim, but acknowledged these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants submit that, as amended, base Claims 1 and 9 are allowable, together with the intervening claims on which Claims 7 and 15 depend. Applicants respectfully request reconsideration and withdrawal of the objection to Claims 7 and 15.

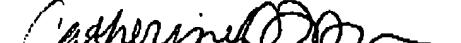
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The Examiner is invited to contact Applicants' representative at the number below, if such contact would facilitate prosecution of this application to allowance.

Respectfully submitted,

By



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